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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,479	11/11/2000	Rika Kusuda	JP919990158	5680

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FERENCE & ASSOCIATES
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EXAMINER

GAUTHIER, GERALD

ART UNIT PAPER NUMBER

2645

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/710,479	Applicant(s) KUSUDA ET AL.	
	Examiner Gerald Gauthier	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. **Claim(s) 1-4, 8-11 and 15** rejected under 35 U.S.C. 103(a) as being unpatentable over Noonen et al. (US 5,761,280) in view of Waldner et al.(US 6,141,413).

Regarding **claim(s) 1 and 8**, Noonen discloses a browser-equipped telephone capable of displaying a web page by a browser (column 1, lines 5-9), comprising:

an inputter (25 on FIG. 1) , which inputs a URL (column 2, line 63 "URL") of a web page (column 2, lines 58-67) [The keypad is used to input the URL of the web page to the GUI Web browser];

a transmitter (10 on FIG. 1), which transmits the URL inputted by the inputter in a form that can be distinguished from a voice message (column 6, lines 1-7) [The interface communicating with the URL inputted by the user in a graphical data on the display]; and

a decoder (10 on FIG. 1), which converts into a character format (column 5, line 39 "home page URL") and sends to the browser the URL reproduced by the answerer (column 5, lines 37-43) [The interface established a connection to the internet site with the home page URL predefined in the web browser].

Noonen discloses the transmitting part of the telephone but fails to disclose the receiving part of the telephone, a receiver and an answerer.

However, Waldner teaches a receiver (FIG. 2), which receives a URL (17 on FIG. 3) and associated voice message (6 on FIG. 2) from the outside through an incoming telephone call (FIG. 2 and 3 and column 7, lines 3-21 and 39-57) [The web-enabled

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terminal 18 is connected to telephony interface 4 and capable of answering telephone call with a client data file including a URL and voice messages, thereby receives a URL and associated voice message from the outside through an incoming telephone call];

an answerer (16 on FIG. 2), which records and reproduces the URL and associated voice message received by the receiver (column 7, lines 39-57) [The client database 16 stores a client data file 17 for each client whose telephone calls are answered, thereby records and reproduces the URL and associated voice message received by the receiver].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Noonan using the teaching of web-enabled terminal as taught by Waldner.

This modification of the invention enables the telephone set to have an alphabetic transmit function so that the user would execute commands by means of character transmission with a voice message.

Regarding **claim(s) 2 and 9**, Noonan as modified discloses the inputter automatically fetches a URL of a web page being displayed and sends the URL to the transmitter (column 3, lines 1-7).

Regarding **claim(s) 3 and 10**, Noonen as modified discloses a URL encoder, which converts into a tone signal format the URL of a character format inputted by the inputter, wherein the decoder converts into a character format the URL of a tone signal format received by the receiver (column 3, lines 8-18).

Regarding **claim(s) 4 and 11**, Noonen as modified discloses a URL function identifier, which determines whether the telephone of the other party has a URL function (column 3, lines 42-57).

Regarding **claim(s) 15**, Noonen and Waldner disclose all the limitation of **claim(s) 15** in the rejection of **claim(s) 1** above and furthermore Noonen discloses a program storage device readable by machine for tangibly embodying a program of instructions executable by the machine [column 2, lines 47-57] to perform, in a browser equipped telephone (FIG. 1) capable of displaying a web page by a browser (20 on FIG. 1), a method for recording a URL of a web page (column 1, lines 5-9).

5. **Claim(s) 5-7 and 12-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Noonen in view of Waldner as applied to **claim(s) 1 and 8** above, and further in view of Silverman (US 6,226,668).

Regarding **claim(s) 5 and 12**, Noonan and Waldner as applied to **claim(s) 4 and 11** differ from **claim(s) 5 and 12**, in that it fails to disclose a URL function identification request at the time a call is placed.

However, Silverman teaches the URL function identifier transmits a URL function identification request at the time a call is placed, and transmits a URL function identification reply in response to a URL function identification request from the other party at the time a call is received (column 4, lines 22-38).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the teaching of a URL function identification request at the time a call is placed as taught by Silverman in the invention of Noonan as modified.

The modification of the invention would offer the capability of a URL function identification request at the time a call is placed such as the system would receive multimedia message.

Regarding **claim(s) 6 and 13**, Silverman teaches the URL function identifier transmits a CTRL function identification request to a calling party at the time a call is received, and returns a URL function identification reply to a called party in response to a URL function identification request from the called party (column 4, lines 39-48).

Regarding **claim(s) 7 and 14**, Silverman teaches the transmitter adds delimiters before and after the URL, respectively, and transmits the URL together with a voice message (column 3, lines 16-33).

Response to Arguments

6. Applicant's arguments filed on September 19, 2005 have been fully considered but they are not persuasive. The applicant stated in page 10 of the remarks that Noonan, Waldner and Silverman fail to teach "while a voice message is played a browser window is opened to a page the caller wishes the recipient of the message to view".

The examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., while a voice message is played a browser window is opened to a page the caller wishes the recipient of the message to view) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

gg
December 4, 2005


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